

ARGUMENTS/REMARKS

The claims have been amended by rewriting Claims 1, 11 and canceling Claims 3, 13. Claims 1, 11 have amended to include the respective limitations of Claims 3, 13 so a new search is not required as no new matter has been added to the amended Claims 1, 11.

Claims 1-2, 4-12, 14-23 remain in the application.

Reconsideration of this application is respectfully requested.

Claim Rejections - 35 U.S.C. § 112:

Claims 1-10 and 14-20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner cites Applicants' specification pg. 13 lines 9-11 for support of an error in claims 1 and 14. The passage that the Examiner has cited applies to a binding update 600. Applicants' specification pg. 13 lines 9-11. Claims 1 and 14 recite a first entry mapping an address of the mobile network node to a mobile network prefix "upon ... next attempting to send packets to the mobile network node" and support for these limitations is found in Applicants' specification pg. 13 lines 12-26.

Claim Rejections - 35 U.S.C. § 102:

Claims 1-10 and 14-20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Johnson et al. (US 6,625,135). After a careful review of Johnson and the claims, it is believed that the rejection is in error and the rejection is, therefore, traversed.

MPEP § 2131 provides:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F. 2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim

Regarding Claims 1-4 and 14-20, the Examiner asserts that “Johnson discloses a method for use in a packet network system comprising a correspondent node and a mobile network node (Figure 1). The correspondent node having an inherent processor sends a packet to the mobile network node causing the correspondent node to receive binding information (col. 16, lines 41-45 and 51-54) which includes a first entry (col. 16, lines 41-45) indicating an association between the mobile network node and a mobile network and a second entry (col. 16, lines 41-45) indicating a proxy address associated with the mobile network. The method comprises storing the entries and using the entries to determine that a packet for a mobile network node is directed to a mobile network reachable by a proxy address (col. 17, lines 4-7 and 10-17). The first entry maps an address of the mobile network node to a mobile network prefix (col. 16, lines 41-45; note: the mobile network prefix is part of the IP address of the mobile router - col. 4, lines 11-30) and the second entry maps the mobile network prefix to a care of address (col. 16, lines 51-54; note: the care of address of the mobile router). Further, regarding claims 16-20, in Johnson the binding updates are sent to a home agent (col. 16, lines 41-45).” Office Action, January 12, 2004, page 3. It is noted that the Examiner’s reliance upon Johnson appears to be misplaced.

First, the Johnson reference is not enabling. “[A] § 102(b) reference must sufficiently describe the claimed invention to have placed the public in possession of it...[E]ven if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling...”. *Paperless Accounting, Inc. v. Bay Area Rapid Transit Systems*, 804 F.2d 659, 665, 231 USPQ 649, 653 (Fed. Cir. 1986). See also, *Akzo N.V. v. U.S.I.T.C.*, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986) (“the prior art reference must be enabling...”). The Examiner cites col. 16 lines 41-45 for support of a mapping of the mobile network node to a care of address of the mobile router. However, the cited passage does not enable the care of address of the mobile router. Specifically, as is known to one of ordinary skill in the art, a mobile router has many addresses associated with the many interfaces that a mobile router interfaces. For example, see Newton's Telecom Dictionary (15th Edition) and <http://webopedia.com/TERM/r/router.html>. A copy of the relevant pages is attached. A typical mobile router has at least two interfaces and each interface has an address. Further, a typical mobile router may also have a third address that is distinct from either of the two interface addresses. In any case, all of these addresses correspond to a mobile router and any one of them could be used as the care of address for the mobile node in the Johnson reference. As the

Johnson reference does not specifically disclose which address is the care of address for the mobile node it is **impossible** to determine the care of address for the mobile node. In Johnson, a discussion of the mobile node's care of address is only incidental to the description as the patent and the cited passage relates to the industrial applicability of a method and apparatus for incorporating environmental information for mobile communications. Thus, the Johnson reference does not enable Applicants' claimed invention as to have placed the public in possession of it. Because the Johnson reference is not enabling, a rejection under 35 U.S.C. § 102(e) is improper and should be withdrawn.

Second, contrary to the Examiner's position that all elements of Claims 1-4 and 14-20 are found in the Johnson reference, the limitation relating to "wherein the first entry maps a home address of the mobile network node to a home address of a mobile router associated with the mobile network; the second entry maps the home address of the mobile router to a care of address," is not, so the rejection is unsupported by the art and should be withdrawn. Described in the Johnson reference is that the care of address of the mobile node is the mobile router's address. As is known to one of ordinary skill in the art and discussed above, this does not disclose "wherein the first entry maps a home address of the mobile network node to a home address of a mobile router associated with the mobile network; the second entry maps the home address of the mobile router to a care of address," of the claimed invention. Applicants' claims require the limitation to "wherein the first entry maps a home address of the mobile network node to a home address of a mobile router associated with the mobile network; the second entry maps the home address of the mobile router to a care of address." Because this limitation is missing from the Johnson reference, a rejection under 35 U.S.C. § 102(e) is improper and should be withdrawn.

Claim Rejections - 35 U.S.C. § 103:

Claims 11-13 and 21-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson et al (US 6,625,135) in view of Malki et al. (US 2001/0046223). After a careful review of Johnson, Malki, and the claims, it is believed that the rejection is in error and the rejection is, therefore, traversed.

MPEP § 2141.03 requires:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

As mentioned above, regarding Claims 11-12 (as amended) and Claims 21-23, the limitation to “the home address of the mobile router as a care of address” for the mobile node is not taught or suggested by the Johnson reference, so the rejection is unsupported by the art and should be withdrawn. Claim 11 has been amended to include all the limitations of Claim 13 which contains the above limitation. Thus, Claim 11 as amended to include a limitation that is not taught or suggest by the Johnson reference. Further, since the Johnson reference does not teach or suggest the claimed invention, Johnson in combination with Malki also does not teach or suggest the claimed invention.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicant’s attorney or agent at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection.


Accordingly, this application is believed to be in proper form for allowance and an early notice of allowance is respectfully requested.

Please charge any fees associated herewith, including extension of time fees, to Deposit Account No. 502117.

Respectfully submitted,

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